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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,493	11/28/2000	Charles J. Torborg	EE-083-US-01	6977

7590

07/26/2005

H.B. Fuller Company
Patent Department
1200 Willow Lake Blvd.
P.O. Box 64683
St. Paul, MN 55164-0683

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,493

Applicant(s)

TORBORG ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 37 is/are pending in the application.
- 4a) Of the above claim(s) 11 to 13, 28 to 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 5, 9, 10, 16 to 27, 32 to 37 is/are rejected.
- 7) ☒ Claim(s) 6 to 8, 14, 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The rejection over Decker et al. has been withdrawn for reasons consistent with that noted by applicants in their response. In addition the Examiner notes that copending 09/724,490 has been abandoned.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1 to 5, 9, 10, 16 to 20, 24 to 27 and 32 to 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Daly et al.
4. Claims 21 to 23, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al.

For both of these rejections, the Examiner relies on the rationale noted in the previous office action. She also draws attention to column 3, lines 44 and 45, which teach melt blending "crystalline materials" (i.e. the carboxylic acid component) with the epoxy component prior to blending with the carboxyl group containing material. This meets the newly added limitation that the component a) be a melt blended mixture.

In an effort to overcome this rejection applicants have provided a Declaration under 37 CFR 1.131 in an effort to antedate the filing date of Daly et al. The Examiner does not find this data sufficient to establish that the claimed composition was conceived and reduced to practice prior to August 21, 2000.

Most importantly the Examiner cannot find in this data any indication that the components (a)(i) and (a)(ii) were melt or extruder blended prior to dry blending with (b). For instance, in part 5 of applicants' remarks (page 2 of the Declaration) they state that the first component (a) *includes* (i) and (ii) but do not state that they are melt blended. Beyond this, the Examiner cannot find reference to melt or extruder blended anywhere in the notebook pages. For instance pages 6 to 8, 13 and 14 each specifically state that components are dry blended.

Adding to the fact that the Examiner is unable to determine much from the notebook pages is the fact that the various components found in the notebook are not

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defined. The Examiner really has no way to determine what was being prepared.

Finally please note that these limited experiments do not provide support for the breadth of the claims, which include a wide glass transition temperature range, many glycidyl acrylic resins, a large genus of curing agents as well as numerous carboxyl group containing materials having a large acid number range.

In view of these points the Examiner must maintain the rejection over Daly et al.

5. Claims 6 to 8 are neither taught nor suggested by the prior art, when limited to the carboxyl group containing elected species currently under consideration. Daly fail to teach or suggest such an amount of component b). See for instance the top of column 9 which teaches from 10 to 50% GMA, which leaves at most a minimum amount of (b) of 50%. The difference between 50% and about 40% is great enough that the skilled artisan would not have found it to be obvious and would not have had reason to expect comparable results. Also, claims 14 and 15 are neither taught nor suggested by the prior art, when limited to the carboxyl group containing elected species currently under consideration. The bottom of column 6 is specific as to which type of catalysts are useful in this composition. These are crosslinking catalysts. In addition, as shown by Hoebeke et al., the presence of catalysts in analogous arts is not always desirable (column 7, lines 65 and on). Thus since it is known in the art that catalysts are not always desirable and can have a negative effect on the matteness, the skilled artisan would have no motivation to try catalysts other than those suggested by Daly et al. Any motivation to use a catalyst within the breadth of claims 14 and 15 would be come from an obvious to try type rationale, which is inappropriate when establishing obviousness.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

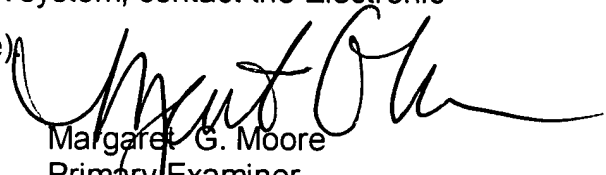
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
7/21/05